

R E M A R K S

Claims **68 -77** are pending.

Claims **68, 72, 76 and 77** are independent.

Claims **72 - 74** were deemed allowable.

Claim Amendments

Claims **27 - 29** were canceled to be pursued in one or more continuing applications.

New claim **75** depends from allowed claim **72**.

New claim **76** is an independent apparatus claim corresponding to allowed method claim **72**.

New claim **77** is an independent apparatus claim which includes all of the limitations of new claim **76**.

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A Request for Continued Examination is filed herewith.

Obviousness-type Double Patenting Rejections

Claims **68 - 74** stand rejected for obviousness-type double patenting in light of U.S. Patent No. 6,381,582.

A terminal disclaimer is filed herewith to obviate the double patenting rejection. Nevertheless, Applicants do not agree that a *prima facie* case of double patenting has been made.

Section 112 Rejections

Claim **73** is rejected for indefiniteness. Claim **73** has been amended solely to correct the antecedent basis error noted by the Examiner, thereby overcoming the Section 112 rejection.

Section 101 Rejections

Claims **68 - 71** stand rejected as directed to nonstatutory subject matter for not including "any references to technology being used to perform any of the claimed steps."

First, the claimed process need not be **performed** via technology even under the current variety of the PTO's "technological arts" requirement. For example, it is also possible to satisfy the current "technological arts" requirement if the claim **involves** or **utilizes** technology (e.g., a process for manually mixing two chemicals, a process for administering a drug). Thus, the pending method claims need not be **performed** by "technology".

Second, the term in independent claim **68** "a point-of-sale system" has been apparently considered not to be "technology" because "a point-of-sale system could be a cash drawer in a store in which places and stores monies received from transactions." It is unclear why even a "cash drawer" would not be considered technology. Clarification is requested as to what the Examiner means by a "cash drawer", and why this would not fit within the definition of "technology".

We note that the characterizations on pages 7 - 8 of the Office Action of what steps would read on the various the claims are mere examples - they are not definitions of the scope of the claims. Indeed, the claims cover many more embodiments that are very different from the example provided by the Examiner. Thus, for example, the statement on page 7 that "In Claim 68, the customer performs at least the first three steps" should read "Claim 68 could be read on an embodiment in which the customer performs at least the first three steps".

Finally, independent claim **68** has been amended to recite receiving "over an electronic network", as recommended by the Examiner. Thus each of claims **68 - 71** includes this limitation. This amendment has been made solely to expedite prosecution and issuance of a patent. The subject matter of the original claim will be pursued in a continuing application as permitted by statute and regulations.

Section 103 Rejections

Claims **68 - 71** stand rejected as obvious in light of Kravitz (U.S. Patent No. 6,029,150). The rejection should be reversed because no *prima facie* case of obviousness has been made.

Kravitz does not suggest the claimed method. The reasoning provided in the Office Action fails to address the full limitation of the claims, and in particular the parties in Kravitz which would perform all steps of claim 68

There is no explanation of how **any single entity** in Kravitz would perform the four steps of claim **68**. The reasoning behind the rejection is essentially that various entities perform variations of the four steps of claim **68**. However, there is no motivation in the prior art of record (and no motivation is alleged) to rearrange the various actions of Kravitz in any manner which renders obvious the four step process of claim **68**.

According to pages 8 - 9 of the Office Action, "little patentable weight is given to the other fields of endeavor in which the payment receiver may be engaged." The justification for ignoring the claim limitations is that "the present claims do not include any transaction being completed with the local seller". Office Action, page 8.

It is not clear what is meant by "the other fields of endeavor" that have been disregarded. Please clarify which claim limitations have been disregarded.

Also, this is clearly not a reason to ignore claim limitations when carrying out the required obviousness analysis. Claim limitations may not be ignored. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

35 U.S.C. § 112, paragraph 6 and claims 72 - 74

Claims 72 - 74 were previously added in order to avail Applicants of the benefits of 35 U.S.C. § 112, paragraph six. The remaining claims do not invoke the provisions of 35 U.S.C. § 112, paragraph six.

The Examiner indicated that

"this paragraph pertains to 'means-plus-function' claims. Since these three method claims are written as a series of steps with no means, apparatus, or device for performing the steps claimed, they are process claims and do not fall under paragraph six."

First, even if the claim elements were 'means-plus-function' elements under § 112, par. 6, they would *not be permitted to* include structure (e.g., apparatus or device) for performing the claimed function. This is, in fact, the very reason for this section of the statute - to permit a claimed function *without reciting structure* in the claim.

Second, 35 U.S.C. § 112, paragraph six does not apply *only* to 'means-plus-function' claims. That section *additionally and equally* applies to 'step-plus-function' claims:

"An element in a claim for a combination may be expressed as a means or **step** for performing a specified function without the recital of structure, material, or **acts** in support thereof, and such claim shall be construed to cover the corresponding structure, material, or **acts** described in the specification and equivalents thereof."

(emphasis added)

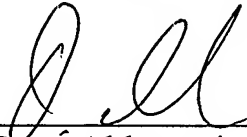
Claims **72 - 74** recite steps for performing functions without recitation of acts for performing those functions. Please examine claims **72 - 74** under the proper analysis required by 35 U.S.C. § 112, paragraph 6.

Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.

Respectfully submitted,



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